



67,064-001 AF IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Jyawook, et al.
Serial No.: 10,077,427
Filed: 02/15/2002
Group Art Unit: 1771
Examiner: Vo, Hai
For: THERMOPLASTIC VEHICLE WEATHER STRIPPING

REPLY BRIEF

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in reply to the Examiner's Answer mailed on June 1, 2004.

In order to establish a *prima facie* case of obviousness, there must be motivation and suggestion from within the art to make a proposed combination. As pointed out in Applicant's opening brief, the Examiner's proposed combination will not work and, therefore, there is no motivation for making the proposed combination. Moreover, one cannot ignore or reverse the express teachings of a primary reference when attempting to combine references to manufacture a *prima facie* case of obviousness. Because the Examiner is doing exactly that here, the combination cannot be made.

The Examiner does not dispute that heating the material of the *Chen, et al.* reference as it exits the die will not result in a microcellular material. Instead, the Examiner proposes to cool the material exiting the *Hendrix* die but that is in direct conflict with *Hendrix's* teachings.

The primary reference relied upon by the Examiner expressly teaches that a first extrudate is formed using a primary die orifice 63 such that the first extrudate has a “closed periphery.” (See, e.g., column 5, lines 28-37). A second extrudate is independently formed from the first or primary extrudate. The *Hendrix* reference teaches that a heat bond is used to secure the first extrudate to the second extrudate. The only way the Examiner can conclude that the improper combination “would provide a workable result” (Examiner’s Answer, p.6), requires extracting the necessary heat bond from the *Hendrix* reference.

To remove the heat bond from the *Hendrix* arrangement would be to remove the manner in which the two extrudates are secured together. This renders the *Hendrix* arrangement useless for its intended purpose.

It is clear from the *Hendrix* reference that the two “independent” extrudates travel through the supporting channel 68 where they are urged against each other to “thereby bond the extrudates to form a composite extrusion.” In the next sentence, the *Hendrix* reference teaches that, “a heat bond is employed.” (Col. 8, line 63 - col. 9, line 2.) *Hendrix* also teaches that supplemental adhesives can be employed. Even when supplemental adhesives are used, however, *Hendrix* never suggests that eliminating the heat bond would be advisable. If it were, there would be no bonding between the two independent extrudates absent some other measures, which are not taught by the art or even imagined by the Examiner.

The Examiner allegedly finds motivation in the *Chen, et al.* reference for cooling the extrudates passing through the *Hendrix* supporting channel rather than heating at least one of them as they exit the *Hendrix* die. The Examiner’s position in this regard can only be based on improper hindsight reasoning. There is nothing within the art to suggest substituting the technique required for forming a microcellular foam into the arrangement of the *Hendrix*

reference, which expressly requires heating extrudates after they exit a die in order to secure them together.

The Examiner's substitution of cooling for heating in the *Hendrix* reference is directly contrary to the express teachings of *Hendrix* and cannot establish a *prima facie* case of obviousness. The Examiner says, for example, "In view of *Chen*, the first and second extrudates are allowed to cool as they exit the die to form a microcellular material." There is nothing within *Hendrix* that suggests that such an arrangement would work. How does the Examiner propose to secure the independently formed extrudates together in a manner sufficient to provide a bond along the entire length of the composite extrudate formed by the *Hendrix* arrangement?

The Examiner's statement that the two extrudates of *Hendrix* "appear not to be separated from each other during the process of forming the weather seal" also is directly contrary to the express teachings of *Hendrix*, which repeatedly states that the first extrudate and second extrudate are formed independent of each other. For example, column 8, lines 51-62, includes the following teachings. "The primary extrudate passes from the primary die orifice 63 with a fully defined cross-sectional profile independent of material flow through the first insert die 120." As noted above, *Hendrix* teaches in column 5 that the primary die orifice 63 defines a closed periphery such that the first extrudate has a predetermined and constant cross-section that is fully defined by passing through the primary die orifice and is independent of an extrudate passing through a different orifice. Only the heat bonding secures the two independent extrudates together. By eliminating the heating operation from the *Hendrix* arrangement, the Examiner is defeating its intended operation.

There is no *prima facie* case of obviousness. The express teachings of a primary reference cannot be ignored. Although the Examiner's Answer "disagrees" with Applicant's

argument on appeal, the Examiner is really disagreeing with the express teachings of the *Hendrix* reference. Moreover, the Examiner's proposed modification to the *Hendrix* reference requires replacing heating with cooling (*i.e.*, requires a substitution that is the exact opposite of the express teachings of the *Hendrix* reference).

Although there is no *prima facie* case of obviousness, Applicant respectfully submits that the submitted declaration regarding commercial success is sufficient to rebut any *prima facie* case of obviousness that may be found. Many of the Examiner's comments in dismissing the declaration are not applicable to this case. For example, this is not a situation where "other business events extraneous to the merits of the claimed invention" have resulted in the commercial success. The claimed invention is not a part of a product that might be commercially successful for any number of reasons (*i.e.*, other features of a product or advertising). Instead, the invention *is* the product. The commercial success therefore is necessarily linked to the claimed invention.

The fact that Applicant has secured a contract for sales in the amount discussed in the declaration is evidence of commercial success. There is no *per se* threshold regarding an amount of commercial success (*i.e.*, market share) that Applicant must cross in order to have "success." Applicant respectfully submits that adequate information has been supplied to show enough commercial success to rebut any *prima facie* case of obviousness.

Applicant respectfully submits that this case is in condition for allowance.

Respectfully submitted,

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Dated: August 2, 2004

CERTIFICATE OF MAILING

I hereby certify that the enclosed **Reply Brief (in triplicate)** is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on August 2, 2004.


David J. Gaskey